



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/922,337   | 08/03/2001  | John Blair           | KM2158.001CP1       | 8212             |
| 20995 7590 06/03/2009<br>KNOBBE MARTENS OLSON & BEAR LLP<br>2040 MAIN STREET<br>FOURTEENTH FLOOR<br>IRVINE, CA 92614 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| WINTER, JOHN M   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 3685   |             |                      |                     |                  |
| NOTIFICATION DATE  |             | DELIVERY MODE        |                     |                  |
| 06/03/2009   |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com

eOAPilot@kmob.com

# Office Action Summary

**Application No.**

09/922,337

**Applicant(s)**

BLAIR ET AL.

**Examiner**

JOHN M. WINTER

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10, 11, 36 and 41-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 11, 36 and 41-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

- I. The Applicants amendment filed on February 26, 2009 is hereby acknowledged, Claims 10, 11 ,36 and 41-62 remain pending. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 26, 2009 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 10, 11 ,36 and 41-62 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
4. Claims 10,11,41 and 44-45 are rejected based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to

another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

5. In this particular case, claim 10 fails prong (1) because the “tie” (e.g. client device ) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.
6. Claims 36, 42,43 and 46-62 are “software per se” the claimed “structure” of the invention is composed entirely of software (e.g. module, interface) and as such is non-statutory.
7. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not

define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. (MPEP 2106.01 --FUNCTIONAL DESCRIPTIVE MATERIAL: "DATA STRUCTURES ")

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 10, 11 ,36 and 41-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites the term "desired format " the "desire" of the user in indefinite, the Examiner recommends "requested format".
9. Claims 11 ,36 and 41-62 are either dependant upon claim 10 or contain similar limitation and are rejected for at least the same reasons.
10. Claim 10 recites the term "receiving from a client device indications of two or more of the content data objects" it is unclear what is being indicated.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 10, 11, 36 and 41-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Toole, Jr. et al. (US Patent 6,279,112) in view of Heindel et al. (US Patent 6,304,857) and further in view of Beattie et al. (US Patent 5,659,742).

12. As per claim 10,

O'Toole, Jr. et al. ('112) discloses a method for transmitting content data over a network of devices comprising:

receiving content data objects from each of a plurality of publishers; (Column 5, lines 23-45) receiving from a client device indications of two or more of the content data objects; (Figure 4A, 4B)

receiving indications from the client device of payment terms and conditions for the transmission of the indicated content data objects; (Figure 4B – elements 128-132)

13. O'Toole, Jr. et al. ('112) does not explicitly disclose initiating transfer of respective portions of a payment from a payment account associated with the client device to each of the publishers of the indicated content data objects. Heindel et al. ('857), discloses initiating transfer of respective portions of a payment from a payment account associated with the client device to each of the publishers of the indicated content data objects, (Column 8, lines 10-39); it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the O'toole, Jr. et al. with the Heindel et al. ('857) method in order to allow the merchant to offload the cost of processing billing transactions.

14. O'Toole, Jr. et al. ('112) does not explicitly disclose receiving indications from the client device of a desired format of one or more of the indicated content data objects; transforming the one or more of the indicated content data objects from respective native formats as provided by the respective publishers to the desired format; and aggregating at least some of the transformed content data. Beattie et al ('742), discloses receiving indications from the client device of a desired format of one or more of the indicated content data objects;(Column 8, line 60 – column 9 line 8 ) transforming the one or more of the indicated content data objects from respective native formats as provided by the respective publishers to the desired format; and aggregating at least some of the transformed content data (Column 27, line 45- column 28 line 11); it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the O'Toole, Jr. et al. with Beattie et al ('742)method in order to allow storage of media in a standardized format.

15. As per claim 41,

O'Toole, Jr. et al. ('112) discloses the method of claim 10

O'Toole, Jr. et al. ('112) does not explicitly disclose transforming one or more of the indicated content data objects from respective native formats to the desired format according to a type of client device accessing the content data objects that were selected. Beattie et al ('742), discloses transforming one or more of the indicated content data objects from respective native formats to the desired format according to a type of client device accessing the content data objects that were selected.(Column 27, line 45- column

28 line 11); it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the O'Toole, Jr. et al. with Beattie et al ('742) method in order to allow storage of media in a standardized format.

16. As per claim 42,

O'Toole, Jr. et al. ('112) discloses the method of claim 10

O'Toole, Jr. et al. ('112) does not explicitly disclose wherein the step of causing said initiating transfer includes determining the portion of the payment due to the respective publisher depending upon a type of the indicated content data objects that were contributed by the publisher. Heindel et al. ('857), discloses wherein the step of causing said initiating transfer includes determining the portion of the payment due to the respective publisher depending upon a type of the indicated content data objects that were contributed by the publisher (Column 8, lines 10-39); it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the O'toole, Jr. et al. with the Heindel et al. ('857) method in order to allow the merchant to offload the cost of processing billing transactions.

17. As per claim 44,

O'Toole, Jr. et al. ('112) discloses the method of claim 10



wherein the content data objects comprise at least one of: digital text data, digital audio data, digital video data, and computer program data. Column 4, lines 51-67)

18. Claims 11, 36 and 41, 43-62 are in parallel with the above rejected claims and are rejected for at least the same reasons.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3685

JMW

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685